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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.    | CONFIRMATION NO. |
|-----------------|-------------|----------------------|------------------------|------------------|
| 10/782,524      | 02/19/2004  | Mervin G. Wood       | CO/21-22849/A/CGC 2144 | 4720             |

324 7590 10/02/2006

CIBA SPECIALTY CHEMICALS CORPORATION  
PATENT DEPARTMENT  
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EXAMINER

BALLS, ROBERT J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1625

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/782,524

Applicant(s)

WOOD ET AL.

Examiner

R. James Balls

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-38 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-38 are pending.
2. This application claims benefit of Provision Application No. 60/450,262 filed on February 26, 2003.
3. Claims 1-38 are subject to election/restriction.

### *Election/Restrictions*

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 4-6 and 18-20, drawn to sterically hindered compounds classified in class 546, subclass 244. Election of a single disclosed compound is also required.
  - II. Claims 7-9 and 21-23, drawn to sterically hindered compounds classified in class 546, subclass 242. Election of a single disclosed compound is also required.
  - III. Claims 10-12 and 24-26 drawn to sterically hindered compounds, classified in class 546, subclass 244. Election of a single disclosed compound is also required.
  - IV. Claims 13-14 and 27-28 drawn to sterically hindered compounds classified in class 546, subclass 188. Election of a single disclosed compound is also required.
  - V. Claims 15 and 29 drawn to sterically hindered compounds, classified in class 544, subclass 212. Election of a single disclosed compound is also required.
  - VI. Claims 1-3 and 16-17 (excluding subject matter claimed in Groups I-V) drawn to sterically hindered compounds, classified in class 546, various subclasses depending on species. Election of a single disclosed compound is also required.
  - VII. Claims 30-33, drawn to a composition comprising an organic material and a sterically hindered compound, classified in class 106, subclass 14.16. An election of a single disclosed organic material and a single disclosed

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sterically hindered compound (from which restriction will apply according to Groups I-VI) is also required.

- VIII. Claims 35, drawn to a composition comprising an organic material, an ultra-violet light absorber and a sterically hindered compound classified in class 522, subclass 6. An election of a single disclosed organic material, a single disclosed ultra-violet light sensor and a single disclosed sterically hindered compound (from which restriction will apply according to Groups I-VI) is also required.
- IX. Claims 36-38, drawn to a composition comprising an organic material, a pigment or dye and a sterically hindered compound classified in class 516, subclass 31.27. An election of a single disclosed organic material, a single disclosed pigment or dye and a single disclosed sterically hindered compound (from which restriction will apply according to Groups I-VI) is also required.
- X. Claims 34 (excluding subject matter claimed in Claims 35-38), drawn to a composition comprising an organic material, at least one coadditive stabilizer and a sterically hindered compound classified in various classes and subclasses depending on species. An election of a single disclosed organic material, a single disclosed coadditive stabilizer and a single disclosed sterically hindered compound (from which restriction will apply according to Groups I-VI), is also required.

Claims 1-3 and 16-17 link inventions I-V and Claims 34 link Inventions VIII-IX.

The restriction requirement between the linked inventions is **subject to the** nonallowance of the linking claim(s), claim 1-3, 16-17 and 34. Upon the indication of allowability of the linking claims, the restriction requirement as to the linked inventions **shall** be withdrawn and any claims depending from or otherwise requiring all the limitations of the allowable linking claims will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104 **Claims that require all the limitations of an allowable linking claim** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments

*classification  
cannot be  
ascertained  
unless a pair  
is selected.*

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submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

Applicants are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, the allowable linking claim, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The inventions are distinct, each from the other because:

Groups I-VI are inventions having independent and distinct chemical structures as evidenced by their different classifications, which lack a substantial structural feature recognized in the art as being essential to the disclosed utility. A reference that anticipates any one group of invention would not render another group obvious. Furthermore, in terms of searching, each group would require a different search, as the groups are not coextensive with each other. Therefore, searching the entire scope of the claims without restriction would pose a tremendous burden on the office.

Should applicants traverse on the ground that the groups are not patentably distinct, applicants should submit evidence or identify such evidence now of record, i.e. show that the compounds of Groups I-V are obvious variants of one another or clearly admit such on the record. Thus, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission that the groups are not

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patentably distinct may be used in a rejection under 35 U.S.C. §103(a) against the other groups.

Groups I-VI are related to Groups VII-X in that they require the same sterically hindered compound encompassed by Groups I-VI. They are patentably distinct, however, based on their different classification and because they contain additional elements such as ultra-violet absorbers, dyes, and stabilizers. For instance, even if the sterically hindered compound were unpatentable, a claim to a composition including the compound may be patentable due to the additional elements. In terms of searching, each group would require a different search, as the groups are not coextensive with each other. Therefore, searching the entire scope of the claims without restriction would pose a tremendous burden on the office.

Groups VII-X are inventions having independent and distinct chemical compositions as evidenced by their different classifications. A reference that anticipates any one group of invention would not render another group obvious. In terms of searching, each group would require a different search, as the groups are not coextensive with each other. Therefore, searching the entire scope of the claims without restriction would pose a tremendous burden on the office.

Again, should applicants traverse on the ground that the groups are not patentably distinct, applicants should submit evidence or identify such evidence now of record, i.e. show that the compounds of Groups VII-X are obvious variants of one another or clearly admit such on the record. Thus, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission that the groups

are not patentably distinct may be used in a rejection under 35 U.S.C. §103(a) against the other groups.

Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed. See 37 CFR 1.143.

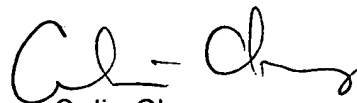
Applicant is reminded that upon the cancellation of claims to non-elected inventions, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. James Balls whose telephone number is (571) 272-7997. The examiner can normally be reached on Mon - Fri 8:00am - 4:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom McKenzie can be reached on (571) 272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

R. James Balls  
September 20, 2006



Celia Chang  
Primary Examiner  
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